



BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS

AF *EPW*

In re Application of: Anthony Nocella, III)
Serial No.: 10/058,643)
Filed: 01/28/2002)
Title: Umbrella With Illuminated Shaft)

Date: September 1, 2004
Group Art Unit: 3637
Examiner: Yip, Winnie S.

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Terry Galus
Name: *TERRY GALUS*

9/15/04
Date

RECEIVED
2004 SEP 20 PM 2:13
BOARD OF PATENT APPEALS
AND INTERFERENCES

BRIEF ON APPEAL

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This is an appeal from the Final Rejection, dated April 22, 2004 for the above identified application.

REAL PARTY IN INTEREST

The party(ies) named in the caption of this brief are the real parties of interest in this appeal.

RECEIVED
SEP 24 2004
OIPET/JCWS

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATEMENT OF AMENDMENTS

There have been no supplemental amendments filed after final rejection.

SUMMARY OF INVENTION

Referring to the specification, page 5, and FIG. 1 and 2, an umbrella is shown, according to the present invention, comprised of a retractable head 2, a support shaft 4, and a handle section 6. It is currently envisioned that the retractable head 2 can be comprised of various types of flexible, water repellant materials in a variety of patterns. The retractable head 2 and shaft 4 operate together to alternately extend, lock, and retract the head 2 in the manner generally typical of umbrellas which are currently, readily available. The shaft of the umbrella is provided with a clear, neon-colored tube 8. A light source or sources, such as incandescent lamps 9, located on the interior of the tube provide bright illumination to make the umbrella user more visible to approaching motorists.

Referring to FIG. 2, the handle section 6 is shown in greater detail affixed to the lower end of the shaft 4. The handle section 6 holds and contains an battery assembly 10, at the upper end of the handle assembly 6, as well as a plurality of batteries 12

which are stored within a cavity inside the handle section 10. A series of threads 14 are formed along the lower rim of the handle, and a screw cap 16 with matching, receiving threads 18 mate to the threads 14 such as to removably contain the batteries 12.

ISSUES

In the Final Rejection of April 22, 2004, the examiner respectfully rejected Claims 1-2 and 5-6 under 35 U.S.C. § 102(b) as being anticipated by Chou et al ('536).

The examiner respectfully rejected Claims 1-2 and 5 under 35 U.S.C. § 102(b) as being anticipated by Tatsumi ('831).

Further still, the examiner respectfully rejected Claims 3 under 35 U.S.C. § 103(a) as being unpatentable over Chou et al or Tatsumi in view of Murphy, and rejected claims 4 and 7 in view of Chou et al or Tatsumi in view of Carso et al.

GROUPING OF CLAIMS

Claims 1-2 and 5-6 form a first group of claims; claim 3 forms a second group of claims, claim 4 forms a third group of claims, and claim 7 forms a fourth group of claims. Each group of claims each stands or falls independently. Each of the groups represents additional limitations that were rejected individually by the Examiner below. Therefore, it is felt that it is reasonable that any argument of novelty or non-obviousness that may apply to one particular claim would not necessarily apply to the others.

ARGUMENT

1. Rejections under 35 U.S.C. 102(b)

The examiner respectfully rejected Claims 1-2 and 5-6 under 35 U.S.C. § 102(b) as being anticipated by Chou et al ('536). And, the examiner respectfully rejected Claims 1-2 and 5 under 35 U.S.C. § 102(b) as being anticipated by Tatsumi ('831).

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Differences exist between the invention claimed in Campbell and the currently claimed invention. Campbell teaches an umbrella having a ray emitting device which is visible in the darkness.

However, Chou et al, I fails to teach a translucent, *neon-colored tube* circumscribing the shaft of the umbrella, but rather teaches a "transparent, solid, polygonal rod", see Claim 1, Col. 2, line 50.

Therefore, in view of the aforementioned differences between Chaou et al and the present invention, the examiner's rejection of Claims 1-2 and 5-6 under 35 U.S.C. § 102(b) as being anticipated by Campbell is inappropriate.

In light of the numerous aforementioned differences between Swarringim and the claimed invention, the examiner's rejection of claims 1, 6 and 7 under 35 U.S.C. 102(b)

is inappropriate.

2. Rejections under 35 U.S.C. 103(a)

The examiner respectfully rejected Claims 1-2 and 5 under 35 U.S.C. § 102(b) as being anticipated by Tatsumi ('831). Tatsumi teaches an illuminated umbrella having a light source in a handle or a shaft, thereby illuminating at least part of the shaft coupled to the handle.

However, Tatsumi fails to *specifically claim* an incandescent lamp; a neon-colored tube circumscribing the shaft of the umbrella; a series of threads formed along a lower rim of the handle; and a screw cap with matching, receiving threads to mate with the threads formed along the lower rim of the handle such as to removably contain the batteries.

Therefore, in view of the numerous differences that abound between Tatsumi and the present invention, the examiner's rejection of Claims 1-5 and 7 under 35 U.S.C. § 102(b) is inappropriate.

Further still, the examiner respectfully rejected Claims 3 under 35 U.S.C. § 103(a) as being unpatentable over Chouet al or Tatsumi in view of Murphy, and rejected claims 4 and 7 in view of Chou et al or Tatsumi in view of Carso et al.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j). Based upon the above arguments, it is felt that the differences between the present invention and all of these references are

such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument application wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

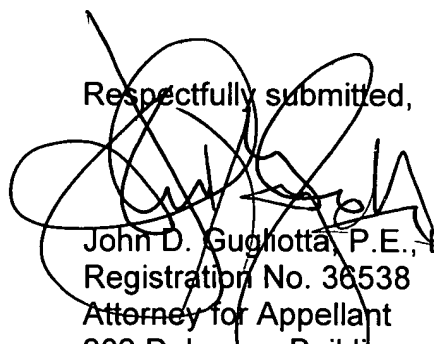
There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a, further comprising an umbrella having an illumination means housed within a handle

section and having a translucent, neon-colored tube circumscribing said shaft of the umbrella. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The Examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,



John D. Gugliotta, P.E., Esq.
Registration No. 36538
Attorney for Appellant
202 Delaware Building
137 South Main Street
Akron, OH 44308

-8-

(330) 253-5678

Facsimile (330) 253-6658

APPENDIX

THE CLAIMS ON APPEAL

The claims on appeal are as follows:

1. An umbrella comprising:
a retractable head; a shaft, said shaft and said retractable head operate together to alternately extend, lock, and retract said retractable head; a shaft lower end;
a handle section, said handle section affixed to said shaft lower end; and
an illumination means affixed to said handle section.
2. The umbrella as described in Claim 1, wherein said illumination means is housed within said handle section.
3. The umbrella as described in Claim 1, wherein said illumination means comprises an incandescent lamp located on the interior of said handle to provide bright illumination to make the umbrella user more visible to approaching motorists.
4. The umbrella as described in Claim 1, further comprising a translucent, neon-colored tube circumscribing the shaft of the umbrella.
5. The umbrella of claim 3, wherein said handle section holds and contains a battery assembly at an upper end of said handle assembly.

6. The umbrella of claim 5, wherein said handle section further comprises:
 - a cavity inside the handle section;
 - a series of threads formed along a lower rim of the handle; and
 - a screw cap with matching, receiving threads to mate with said threads formed along the lower rim of the handle such as to removably contain the batteries.

7. An umbrella comprising:
 - a retractable head; a shaft, said shaft and said retractable head operate together to alternately extend, lock, and retract said retractable head; a shaft lower end;
 - a handle section, said handle section affixed to said shaft lower end;
 - an illumination means housed within said handle section; and
 - a neon-colored tube circumscribing said shaft of the umbrella.